

PATENT

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Inventor : Michael Hinnebusch
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For : SYSTEM AND METHOD TO IMPROVE FITNESS
TRAINING
Group Art Unit : 3628
Examiner : NELSON, Freda Ann

MS: Appeal
Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REPLY BRIEF ON APPEAL
ON BEHALF OF APPELLANT**

S I R :

This is a Reply to the Examiner's Answer mailed January 21, 2010.

A Request for Oral Hearing is filed herewith.

I. Summary of the Claimed Subject Matter

At page 2 of the Answer, the Examiner states that the Summary of the Claimed Subject Matter is correct.

In preparing the Reply, Applicant noticed that there had been a cut-and-paste error in the first paragraph of the Summary. The Summary is correct regarding "The claimed subject matter is believed to be summarized well in claim 1, which is as follows... More particularly, please see the chart below and note that one manner of viewing support for the claims is as follows...." A

cut-and-paste error inserted an incorrect claim within this text, and the first paragraph should instead read:

"The claimed subject matter is believed to be summarized well in claim 1, which is as follows: An apparatus to produce an exercise routine personalized by a user, the apparatus including: a first computer system programmed so as to facilitate forming machine-readable instructions corresponding to a personalized exercise routine, wherein said machine-readable instructions are protected as private to the user; a portable memory device storing the personalized exercise routine formed in the machine-readable instructions and received from the first computer system; and a second computer system programmed to carry out operations comprising user-triggered enabling of: translating the private personalized exercise routine, stored in the portable memory device and retrieved from the portable memory device, to a different personalized private exercise routine for each different type of user-selected exercise machine, controlling an exercise machine in carrying out the different personalized private exercise routine. More particularly, please see the chart below and note that one manner of viewing support for the claims is as follows....

Applicant apologizes for the confusion.

II. Reply to Examiner's Answer

In Reply to Examiner's Answer regarding Groups 1, 2 and 3, it is respectfully submitted that the Examiner is interpreting the claims broader than reasonable and in a manner that is inconsistent with Appellant's specification and In re Morris, 127 F.2d. 1048, 44 USPQ2d 1023 (Fed. Cir. 1997).

In the Answer, the Examiner repeatedly refers to MPEP 2111.01.111 for guidance

regarding how to interpret the claims in light of the specification. Attention is respectfully drawn to the Answer, e.g., Paras. 5, 8, 15, etc. There is no such MPEP section. And if the Examiner's assertion in Para. 5 etc. were correct about defining each term, every applicant would have to provide a deliberate definition for each claim limitation in each claim.

Though Applicant prefers to rely on case law, in order to reply to the Examiner's Answer, Appellant presumes that the Examiner is referring to MPEP Sec. 2111, and if so then the Examiner seems to be parsing the MPEP out of context, much like the Examiner has done with the claims. In the MPEP, the Examiner appears to have ignored the portion of MPEP Sec. 2111 which states:

...*In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (Claim 9 was directed to a process of analyzing data generated by mass spectrographic analysis of a gas. The process comprised selecting the data to be analyzed by subjecting the data to a mathematical manipulation. The examiner made rejections under 35 U.S.C. 101 and 102. In the 35 U.S.C. 102 rejection, the examiner explained that the claim was anticipated by a mental process augmented by pencil and paper markings. The court agreed that the claim was not limited to using a machine to carry out the process since the claim did not explicitly set forth the machine. The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.").

So the Examiner's contentions about the MPEP in the Answer in Paras. 5 etc., about claim interpretation, appear to have no basis in the MPEP section apparently relied upon in the rejections. Instead, consistent with the MPEP, while it is well established that reasonably interpreting claim limitations broadly may be appropriate, the interpretation must be appropriately contextual and consistent with the teachings of the specification.

Applicant asserts that in construing claim limitations it must be kept in mind that “as an initial matter, the PTO applies to the verbage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions *or otherwise* that may be afforded by way of the written description contained in applicant’s specification.” In re Morris, 127 F.2d. 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

Appellant was not suggesting the Examiner read limitations from the specification into the claims, but rather was trying to help the Examiner focus on the limitations in the proper context afforded by way of the written description contained in applicant’s specification. Thus, in interpreting the claims, the Examiner cannot ignore the specific context of the claim limitations in the specification.

For example since the Appellant did not include a statement like “by translation we mean” in the specification, it would be reasonable to interpret the claimed limitations of “translating the private personalized exercise routine....to a different personalized private exercise routine for each different type of user-selected exercise machine...” to mean programming “routines are translated into machine-readable instructions for another machine” as urged by the Examiner. Simply put, translating exercise routines does not mean translating computer programs, and this interpretation of the claims is not reasonable because it is inconsistent with Appellant’s claims and specification.

The Examiner has pointed out that Shaw’s monitor has a “universal nature of the exercise monitoring unit 100...can be connected to any exercise machine” and that “operator input determines the correct performance data for the user on a particular exercise machine”. However, the Examiner has unreasonably and improperly interpreted Shaw’s having an ability to run programs on different machines for monitoring a user’s performance so as to urge

anticipation of Appellant's claim limitations specific to translating a private personal exercise routine for a first machine to a second machine and then carrying out different private personal exercise routine by controlling the second machine.

See Appellant's claim limitation which translates the private personalized exercise routine between a first and second machine then controls the equipment based on that routine. Exercise routines are specific to the type of exercise equipment controlled. See Appellant's claim limitation regarding translating the private personalized exercise routine between one machine like a treadmill (e.g., in specification) to a second machine, like a bike (e.g., in specification), and controlling an exercise machine in carrying out the different personalized private exercise routine. Examiner is attempting to equate Shaw's universal monitor, which may connect to the treadmill and a bike to monitor an individual's performance data, with Appellant's limitations of translating the private personalized exercise routine...to a different personalized private exercise routine for each different type of user-selected exercise machine...controlling an exercise machine in carrying out the different personalized private exercise routine, as recited in claim 1. The same deficiency in the Examiner's reasoning also applies to claim 3, which for example recites translating the private personalized exercise routine...to a different personalized private exercise routine for each different type of user-selected exercise machine...carries out one said different personalized private exercise routine and to claim 76 which recites carry out the operations of translating a private personalized exercise routine...to a different private personalized exercise routine for each different type of user-selected exercise machine an exercise machine of at least one said type is controlled with one said different private personalized exercise routine.

Further, Shaw's disclosure of a personal universal portable monitoring unit that monitors the user's exercise performance between the machines, cannot be properly interpreted to anticipate Appellant's claims, which translates the user's private personalized exercise routine

from one machine to a second machine and then controlling that second machine consistent with the translated private exercise routine (see claims for more complete language as a whole). A monitoring program running on different computers is not a reasonable interpretation for translating exercise routines and controlling the different exercise machines based on the translation of the exercise routine.

The Examiner continues to parse the claim language, out of context, and applies inappropriate, contradictory, and unrelated interpretations of the claimed elements to try to construct a rejection. This is hindsight reconstructing of the pending claims and is contrary to giving the claims their broadest reasonable interpretation *consistent with the teachings of the specification*. For Examiner's claim interpretations to stand, would require ignoring Appellant's specific teachings of translating the private personalized exercise routine, stored in the portable device and retrieved from the portable memory device, to a different personalized private exercise routine for each different type of user-selected exercise machine and then controlling an exercise machine in carrying out the different personalized private exercise routine to mean monitoring user performance between different exercise equipment, as disclosed in Shaw. This is an unreasonable interpretation of the claims and is contrary to In re Morris.

With regard to paragraph 9, the Examiner states that she was "unable to locate Appellant's first priority date of April 1, 2000," referred to by Appellant. In response, presumably Ser. No 60/196,498 is in the PTO files, and if it has been lost by the PTO, Applicant's file is complete and a copy can be supplied for reconstruction of the PTO files. Applicant's position was asserted long ago in prosecution, and Applicant should not be penalized for the Examiner waiting until the Answer to contend that she was "unable to locate Appellant's first priority date of April 1, 2000." The Examiner's inability to locate having not been timely raised by the Examiner should not be permitted to prejudice Applicant at this point.

With regard to paragraph 11, Appellant stands on the point that the Examiner was completely silent on these particular points, and the Board can confirm so by checking the record. The points having not been timely raised by the Examiner should not be permitted to prejudice Applicant at this point.

With regard to paragraph 16, the Examiner apparently misunderstood Appellant's pointing out that Watterson et al. does not remedy the deficiency in Shaw of not teaching the limitation of "translating the private personalized exercise routine". Appellant is not arguing the references separately.

With regard to paragraph 17, Examiner continues to fail in providing any teaching within the Shaw, Watterson, or Peterson, of protecting instructions as private to a user. None of the art teaches protecting as claimed.

III. Conclusion

The first step in analyzing patentability is to interpret the claims, and this involves giving the claims their broadest reasonable interpretation *consistent with the teachings of the specification*. The rejections are premised upon improperly construing the claims, in violation of In re Morris.

As to the rejection of claims 1, 3, 5-6, 20, 62, 76-77 pursuant to 35 U.S.C. 102(b), the rejection is improper because at least one claim element for each said claim has not been shown in the cited art. Prima facie anticipation has not been shown.

As to the "obviousness" rejections of the remaining pending claims, each of the claims being dependent, the aforesaid deficiencies carry through to the dependent claims. Thus, Appellant respectfully submits that the individual teachings of US Patent 4,817,940 (Shaw), 6,458,060 (Watterson et al.) fail to teach the claimed invention as a whole, and the additional teachings of 6,527,674 (Clem), 5,502,806 (Mohoney et al.) and Netpulse.com do not remedy the

difficiencies in Shaw et al. and/or Watterson et al. Accordingly, the rejections are improper for failure to make out a prima facie case of obviousness pursuant to 35 U.S.C. 103(a).

Thus, for the reasons more fully set out above, all pending claims and the aforesaid groups of claims have not been shown unpatentable. Allowance is respectfully requested. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,



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